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STATUS OF THE CLAIMS

This is in response to the Office action dated September 6, 2005, in which claims 6, 10 and 11 were allowed; claims 9, 19 and 20 were indicated as allowable if rewritten; and claims 2, 4, 5, 7, 8, and 12-18 were rejected, despite claims 2, 7, 8, and 12-18 being among those allowed or indicated as allowable in the previous Office action. The applicant is appreciative of the allowed subject matter. Claims 9, 19 and 20 have not been rewritten in independent form at this time, pending action on the present response. The applicant hereby requests that the examiner allow claims 2, 4, 5, 7, 8, and 12-18, in addition to claims 6, 9-11, 19 and 20, in light of these remarks.

GROUNDS OF REJECTION TO BE REVIEWED: CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE
NOT RENDERED OBVIOUS BY BROOKS AND JOHNSON

Claims 2, 4, 5, 7, 8, and 12-18 (“the present claims”) were rejected under §103(a) due to US patent 4,895,380 issued to Brooks et al. (“Brooks”) combined with US patent 5,711,227 issued to Johnson (“Johnson”). However, the applicant maintains that Brooks and Johnson do not render claims 2, 4, 5, 7, 8, and 12-18 obvious, and asks the examiner to reconsider this rejection. In particular, each of the first three of the *Graham* factual inquiries independently argue against the finding of obviousness of claims 2, 4, 5, 7, 8, and 12-18. Specifically, Brooks and Johnson do not provide prior art the scope and contents of which would render the present claims obvious, because Johnson is not analogous art; the differences between Brooks and Johnson and the present claims are too great for the claims to be obvious, because there would have been no motivation to combine the disclosures of Brooks and Johnson, and further because Brooks and Johnson teach away from each other; and the rejection of claims 2, 4, 5, 7, 8, and 12-18 does not take into account the level of ordinary skill in the art of the present invention, because that level of skill does not include the breadth of knowledge to make the cited combination. Ultimately, the rejection of the present claims drops an overly and unstatutorily strict gate in the way of the allowance of the patentably inventive present claims. Since

"[v]irtually all inventions are combinations... of old elements", *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161, 1179 (Fed Cir. 1991) (cit. omitted), these *Graham* factor evaluations – including distinctions of non-analogous art, lack of motivation to combine references, references teaching away from each other, and properly evaluating the ordinary level of skill in the pertinent art – are of critical importance for protecting the inventive and patentable combinations of the present claims from an unfairly broad application of §103, and indicate that claims 2, 4, 5, 7, 8, and 12-18 are not obvious and should be allowed.

CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS
BECAUSE BROOKS AND JOHNSON ARE NOT FROM ANALOGOUS ARTS

The scope and contents defined by Brooks and Johnson would render the claims obvious, in particular, because Johnson is not from an art analogous to the present claims. A reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. M.P.E.P. 2141(a); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). A reference is in a different field of endeavor if it teaches use in a different structure, for a different purpose, under different conditions, than the claimed invention; and a reference is not reasonably pertinent to the problem with which the inventor was concerned if a person of ordinary skill in the art would not reasonably have expected to solve the problem of the claimed invention by considering references in the art of the reference. M.P.E.P. 2141.01(a); *In re Clay*, 23 USPQ 1058 (Fed. Cir. 1992). Johnson teaches a different structure, for a different purpose, under different conditions, than the inventions of the present claims, and a person of ordinary skill in the art of the present claims would not reasonably have expected to solve the problem of the claimed invention by considering references in the art of Johnson, as elaborated below.

The Johnson reference was picked out of a non-analogous art relative either to Brooks or the present invention, rendering the combination an unfairly expansive evaluation of the scope and contents of the prior art. Specifically, Johnson is from the field of art of moving

motion picture cameras steadily while filming therewith. The disparity between the field of art of Johnson, i.e. of a conveyor system for a collapsible and portable dolly system for filming movies, from the field of art of the present invention, is too great to be considered analogous.

The structure of the Johnson subject matter is very different from the structure of either Brooks or the present invention, in that it is dominated by a tripod with a movie camera perched on top thereof; it has no place where a user might reasonably be supported, and indeed is not apparently capable of supporting the weight of someone who were to try to ride on it, without being at risk of damage. The structure of the Brooks subject matter is also very different from the structure of either Johnson or the present invention, in that it is devoid of a rail. The function of Johnson is in stark contrast from that of either Brooks or the present invention, in that it is intended to carry a movie camera, rather than a human user, and in that its purpose is to allow that movie camera to shoot while in motion with a reduction in mechanical disturbances of the movie camera's tracking shot. Further, the conditions under which the Johnson subject matter is intended to be used are extremely different from the conditions under which the claimed invention is most likely to be used. The Johnson invention is most likely to be used in a clean, carefully controlled environment, in which all activity is under the control of a director, and in which a very expensive, fragile movie camera, perched on top of a moving tripod, would not be at risk of damage. In stark contrast, the present invention is contemplated, among other uses, for use in harsh outdoor conditions, particularly including relatively hazardous and chaotic construction sites, for use on dirty, gravelly surfaces, and to pass under dirty, oily trucks, construction vehicles, and other work machines. As stated in the application, the advantages envisioned of the present invention include use in "environments where the ground surface within which a mechanic must work is rough, rocky, gravelly, sandy, soft, or otherwise not substantially smooth and hard. Many applications for usage of a creeper necessarily incorporate conditions such as these and cannot be delayed or transferred to a garage. This is the case, for instance, when repair or maintenance must be done on specialized motor vehicles, trucks, construction equipment, and other mechanical machines located on a construction site or other field location." (Application.)

Brooks and Johnson share little if anything in common, in terms of structure, other than things having some sort of frame with wheels attached; and in terms of function, other than to facilitate motion of some thing; and in terms of conditions of use, other than some place within the realm of human activity. The disparate variety encompassed by these structures, functions, and conditions of use, define a vast, amorphous universe of subject matter, in the breadth of which it would be impossible for any mortal person to become skilled; and an invention can hardly have been obvious if no person can have been of ordinary skill in the entirety of the arts needed to provide references that disclose (assuming *arguendo* that they do) all the elements of that invention.

Johnson therefore teaches use of a portable and collapsible dolly and track having a very different structure, for a very different purpose, under very different conditions of use, than the invention of the present claims. As explained by the Court, this presents compelling evidence that Johnson is not from an analogous art to that of the present claims, and does not properly speak to whether or not the present claims are obvious under §103. Furthermore, a person of ordinary skill in the art of the present invention would not reasonably have expected to solve the problems resolved by the claimed invention by considering references in the art of auxiliary equipment for filming motion pictures, providing further powerful evidence that Johnson is inapposite to the evaluation of the present claims under §103.

The conclusion that Brooks and Johnson are non-analogous arts, impermissible to combine for §103, is further supported by the lack of any overlap in the classifications, domestic or international, or fields of search, of the Brooks and Johnson references. This is further indicative that a person of ordinary skill in the art of either one of the two references would not have considered investigating the field of art of the other reference as an analogous or reasonably pertinent source of knowledge for a particular problem.

The fact of Johnson's non-analogy from the art of the present invention shows that the only rejection of the present claims is not sustainable. The applicant therefore respectfully requests that the Examiner withdraw this rejection and allow claims 2, 4, 5, 7, 8, and 12-18.

CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS
BECAUSE THERE WAS NO MOTIVATION TO COMBINE BROOKS AND JOHNSON

The differences between Brooks and Johnson and the present claims are also too great for the claims to be obvious, because there would have been no motivation to combine the disclosures of Brooks and Johnson. Obviousness rejections must include an objective showing of specific facts to demonstrate a motivation to combine the references. *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Obviousness rejections made without this requisite showing have been consistently overturned, in a testament to the importance of this safeguard against undue exclusion of patentable inventions from the issuance of a patent. The differences between the cited references and the present claims, following the second of the *Graham* inquiries, therefore also provide an independent reason why the current obviousness rejection should be withdrawn and the present claims allowed.

In particular, there is no demonstrated suggestion or motivation to combine Brooks and Johnson, either explicitly in the references themselves, or more tenuously in the general knowledge of those in the relevant arts or in the nature of the problem to be solved. None of these possible sources of motivation to combine the two references has been demonstrated by a factual inquiry of objective evidence, as would be required to establish a showing of obviousness. The post hoc pairing of the dramatically disparate Brooks and Johnson references goes beyond any suggestion or motivation that anyone of ordinary skill in the arts of either reference would be alerted to, in staying competently informed within her own specialty. A motivation ascribed alternately to a nebulous common knowledge in the art would not fairly represent the reality of two separate fields of art, each with its own community possessing its own unique common knowledge: one community of persons with ordinary skill in the art of creepers, who might consider Brooks well-known in their art; and a separate community of persons with ordinary skill in the art of auxiliary equipment for shooting a motion picture, who might consider Johnson well-known in their art. A single individual who considered these two references from these two disparate specialties well-known, would not be a person of ordinary

skill in one art or the other, but rather a person of particularly extraordinary skills across a polymathic range of arts, compared to whose talent little if anything might not be obvious. Such a standard would present an unfair and unstatutory yardstick for evaluating claimed inventions under §103.

Neither the cited references, nor the common knowledge of those in the art or the nature of the problem to be solved, include a suggestion to combine the disclosures of these two references as demonstrated by a specific factual inquiry of objective evidence. Even assuming *arguendo* that Brooks and Johnson were to disclose or suggest every element of each of the present claims between the two of them, the present claims are not shown to be obvious without such a specific fact finding that a person skilled in the art at the time of the invention of the present claims would have had a motivation to combine the teachings of these two references. Such a specific fact finding from objective evidence has not been shown. This is indicative that such a combination was in fact inventive, and deserving of being awarded a patent.

CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS
BECAUSE BROOKS AND JOHNSON TEACH AWAY FROM THEIR COMBINATION

The differences between Brooks and Johnson and the present claims are too great for the claims to be obvious, because Brooks and Johnson teach away from each other. This provides compelling evidence that a person of ordinary skill in the art at the time the present claims were invented would not have had motivation to combine the Brooks and Johnson references. It is improper to combine references where references teach away from their combination. M.P.E.P. 2145(X)(D)(2); *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983).

As a particular example, Brooks emphasizes being properly proportioned and providing the necessary support for a mechanic. For example, Brooks points out that a hospital gurney is improperly proportioned for use by an automobile mechanic. That being said, a person of ordinary skill in the art of Brooks would likely have been motivated *a fortiori* by the teaching of Brooks to dismiss out of hand a reference teaching a structure that is all the more improperly

proportioned for and incapable of supporting a mechanic, such as a dolly for a movie camera, even more so a dolly of such unusually insubstantial weight that it may be “assembled in a matter of minutes”, and portable “in a tote bag”, as taught by Brooks. Conversely, Brooks is replete with description of the suitability of the described creeper for a mechanic to recline his full weight thereon, and to manipulate gears and a hydraulic jack thereof while remaining supine upon the creeper; a person of ordinary skill in the art of auxiliary equipment for movie cameras would likely regard such teachings as unhelpful or irrelevant to a dolly with a tripod that is not intended and is not likely to admit a user reclining thereon, and further, indicative of a structure far stronger and heavier than would be required to support a mere movie camera, and precisely in opposition to the desired unusually light weight, following the teaching of Brooks.

The combination of Brooks and Johnson therefore does not properly speak to the evaluation of the non-obviousness of the present claims. On the contrary, the present claims describe a new and unobvious invention, deserving of allowance.

CLAIMS 2, 4, 5, 7, 8, AND 12-18 ARE NOT RENDERED OBVIOUS BECAUSE
KNOWLEDGE OF JOHNSON IS OUTSIDE THE ORDINARY SKILL IN THE ART

The rejection of claims 2, 4, 5, 7, 8, and 12-18 does not take into account the level of ordinary skill in the art of the present invention, because that level of skill does not include the breadth of knowledge to make the cited combination. The ordinary level of skill in the art of the present invention is likely to center on familiarity with the mechanical structure and function of construction vehicles and other motor vehicles, familiarity gained by experience and training that would be unlikely to include a detailed investigation of the specialized technologies of modern motion picture production. It is improper to evaluate ordinary skill of persons in the art by considering instead what would “have been obvious... to those skilled in remote arts.” M.P.E.P. 2141.03; *Environmental Designs, Ltd. v. Union Oil Co.*, 218 USPQ 865, 869 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984). Auxiliary equipment for filming motion pictures must be considered a remote art from the perspective of persons of ordinary skill in the art of creepers.

Therefore, a proper adherence to the third of the *Graham* factual inquiries also, independently of the evaluation under the first two *Graham* inquiries, indicates that Johnson does not speak to the question of obviousness for the present claims.

CONCLUSION: CLAIMS 2, 4, 5, 7, 8, AND 12-18 SHOULD BE ALLOWED

At least four legal rules spanning each of the first three *Graham* inquiries independently indicate that Brooks and Johnson do not render the present claims obvious. The applicant thereby respectfully submits that the entirety of the application is now in condition for allowance, and requests that the examiner allow claims 2, 4, 5, 7, 8, and 12-18, in addition to claims 6, 9-11, 19 and 20.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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